

REMARKS

By the foregoing amendment, Applicant has presented new claims 33-34 which further defines the subject matter that Applicants regard as their claimed invention with regard to the surfaces of the groove exhibiting both a surface that is created by a rotating milling tool, as well as a smoother surface formed by a broaching tool. Support for such claimed limitations can be found in the original disclosure, for example, in the first 25 lines on page 4 of the specification. New claim 34 also finds support in the same portion of the disclosure.

Reconsideration of the previous rejections as set forth in the Office Action of January 11, 2008, are respectfully requested in view of the following comments.

Claim 32 stands rejected under 35 USC §112, second paragraph, allegedly as being indefinite.

Applicants have positively recited, in accordance with the mandate of Congress as set forth in 35 USC §112, second paragraph, the subject matter “which the Applicant regards as his invention”. Applicants pointed out, for example, in page 4 of the specification, what they regard as the characteristics of a milled surface and what they regard as a characteristic of a broached surface. It is apparent that the Examiner has not been able to find any prior art as to the limitations of claim 32 as there is no prior art rejection as to such claim. However, the Examiner cannot, under the guise of not understanding the claimed invention, to require Applicants to further limit the claimed invention to satisfy the Examiner’s conception of “what the invention is”. The court has long ago concluded that the Examiner’s approach to determining whether Appellants’ claims satisfy the requirements of §112, second paragraph, as in the case of *In re Borkowsky*, 164 USPQ 642, 645 (CCPA 1970) as not being condoned.

As the Court therein stated:

“the Examiner’s approach to determining whether Appellants’ claims satisfy the requirements of §112, appears to have been the study of Appellants’ disclosure, to formulate a conclusion to what he (the Examiner) regards as the broadest invention supported by the disclosure, and then to determine whether Appellants’ claims are broader than the Examiner’s conception to what “the invention” is. We cannot agree that §112 permits such an approach to claims”.

Applicants respectfully submit that the Examiner’s rejection under 35 USC §112, second paragraph, especially in view of the failure of the Examiner to cite any relevant prior art, is clearly patentable and withdrawal of the rejection is therefor respectfully requested.

The previous rejections of claims 24 and 27-31 under 35 U.S.C. §102(b) as anticipated by Moriau et al (U.S. Patent No. 6,006,486) is respectfully traversed.

The Examiner recognizes that Moriau does not expressly teach the claimed invention by his failure to point out the words used by Moriau to anticipate the claimed features. Rather, the Examiner treats the claimed limitations as “product-by-process limitations” and affords them no weight. However, by asserting that the Examiner affords no weight to the claimed limitations as not being limitations of the product, the Examiner has only shifted the burden to Applicants to show that Moriau does not inherently teach the claimed invention.

In this regard, Applicants present the rule §132 Declaration of Fredrik Schlyter, an employee of the Assignee of the above-identified application.

Declarant is familiar with the invention, including the Office Action rejecting the present claims, and the Examiner’s statement in the Office Action of January 11, 2008, that the Examiner is of the opinion that “Examiner notes that either the tongue or groove, having a broached portion having angles sharper than possible by milling, does not positively define an end resultant product, i.e. surface comprised of a plurality of boards having a joint connection between the boards that is patentably distinct from the prior art of record”. Contrary to the Examiner’ argument, the declaration

of Schlyter presents proof that the limitations of the claims do positively define the structure of the product i.e. by reference to an angle in the tongue or grooves which cannot be made by milling, See for example, paragraph 5 of the Declaration of Schlyter. The evidence of Schlyter in paragraphs 6, 7, 8 and 9, clearly shows that there is a difference between the claimed invention and the product shown in the Moriau et al reference. Additionally, the Declarant states that “commercially milled products cannot be made to have angles achievable only by the broaching” (of the invention).

Therefore, the Examiner is incorrect in alleging that the Moriau product expressly and/or inherently anticipates the claimed invention.

The Examiner’s comments concerning Serino have no place in the anticipation rejection based on Moriau.

In view of the Declaration and the foregoing remarks, Applicants respectfully submit that the rejection of claims 24 and 27-31 are unsustainable under the grounds of anticipation over Moriau.

Additionally, Applicants have presented claims 33 and 34 which particularly point out and distinctly claim the subject matter Applicants regard as their invention and are not taught by the Moriau reference. New claim 33 requires that both a milled surface and a broached surface are present in a system, including a board having a groove, where the milled and broached surfaces are part of the groove. New claim 34 requires the material of the groove to be formed of medium density or high density fiber board. These claims are fully supported by the original disclosure e.g., the disclosure on page 4 of the specification and there is no teaching in the disclosure of Moriau reference for a groove having a surface which shows a surface formed by a rotating milling tool and a smoother surface formed by a broaching tool, but not possible by milling. Therefor, the claims recite structural differences of the product and again no teachings of Moriau show these differences. Applicants respectfully submit that claims 33 and 34 are therefore not anticipated by the Moriau et al reference.

Reconsideration of the previous rejection of claims 24 an 27-31 under 35 U.S.C. §103(a) as being unpatentable over Moriau is respectfully requested.

Again, the Examiner recognizes the differences between the claimed invention and again states that the product-by-process limitations are absent any structure to the end resultant product. Here, again the Examiner is mistaken.

Applicants respectfully submit that in view of the Declaration of Schlyter, the claimed product is not the same as, nor obvious over, the product of Moriau for all of these reasons set forth in the Declaration above, as well as the foregoing comments. Accordingly, Applicants have satisfied their burden in rebutting the allegation, not only of anticipation, but also of obviousness as set forth in the previous Office Action.

Reconsideration of the previous rejection of claims 21-23 and 25 under 35 USC 103(a) as being unpatentable over Moriau (discussed above) in view of Serino et al (US Patent 6,357,197) is respectfully requested. While the Examiner alleges that Moriau does not disclose a tongue and groove comprising a milled polymeric material, Applicants are not merely claiming a tongue and groove comprising polymeric material, but rather a tongue and groove comprising milled and broached surfaces on the polymeric material. In the Serino disclosure, Serino teaches forming a composite structural member by first obtaining a “linear member” by preparing a composite member by milling a wooden member or extruding an aluminum piece into a desired profiled shaped, or obtaining such a member to act as a linear member see, for example, the Detailed Description of the Invention of Serino, beginning at column 3, lines 20-23.

Such a “linear member” of Serino is then prepared for joining a thermoplastic end piece to each end of the linear member. However, such thermoplastic material is “molded with a joinery surface” (column 3, line 37) or “extruded in a substantially solid form in a profile shape that matches the cojoined article (column 3, lines 37-41). However, there is no disclosure wherein at least the groove portion comprises a broached portion, as well as a milled portion as claimed. Thus, the Examiner has not corrected the foregoing deficiencies of Moriau and does not reach the additional limitations of dependent claims 21 and 23. With regard to claim 25, although it is alleged that Serino discloses a wood fiber board as a core, Serino does not, in fact, teach fiber board, but rather in his

disclosure of the materials of the linear member beginning at column 7, line 28 only discloses “wood, metal or an engineering resin” as a possible materials for the linear member. Thus, there is no disclosure of fiber board as a linear member of Serino. Serino also does not teach the “medium density or high density fiber board” of new claim 34.

For all the foregoing reasons, withdrawal of all rejections and passage of the application to issue are respectfully requested.

The Director is hereby authorized to charge any deficiency in the fees filed, asserted to be filed or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Deposit Account No. 14-1437, under Order No. 8688.019.USDV00.

Date: July 11, 2008

TPP:tnj

Respectfully submitted,



Thomas P. Pavelko
Registration No. 31,689
NOVAK DRUCE & QUIGG LLP
1300 Eye Street, NW
1000 West Tower
Washington, DC 20005
Telephone: (202) 659-0100
Facsimile: (202) 659-0105